

## **REMARKS**

In the Office Action, the Examiner rejected claims 1-27 and 31-37 were rejected under 35 USC § 103(a). These rejections are fully traversed below.

Claims 1-27 and 31-37 are pending in the application. Reconsideration of the application is respectfully requested based on the following remarks.

### **The 35 U.S.C. § 103 Rejection**

Claims 1-8, 10-21, 23-25, 31, 32, 34 and 37 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Gardos et al. (USP 7,251,826) in view of Meunier et al. (USP 6,681,369), and claims 9, 22, 26, 27, 33, 35 and 36 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Gardos et al. in view of Meunier et al. and further in view of Hollenbeck (US Pub. 2005/0102354). These rejections are respectfully traversed below.

According to the Manual of Patent Examining Procedure (M.P.E.P.) § 2143,

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.

Specifically, the Office Action appears to contend that Gardos teaches elements (a) through (d) of claim 1. Additionally, the Office Action states: "Gardos however does not explicitly teach that subsequent to the receiving (a) of the request to monitor the name, the searching (c) and the notifying (d) are periodically automatically performed. On the other hand, Meunier teaches monitoring agent which automatically tracks changes in documents (information) (column 5, lines 29-48), by periodically accessing the document or information and then notifying a user about the changes (col. 5, lines 49-56)." The Applicants respectfully disagree for the reasons, among others, set forth below.

Applicant respectfully submits that Gardos is completely deficient. Claim 1 pertains to a computer-implemented method for monitoring domain name registrations. The method recites:

- (a) receiving a request to monitor a name;
  - (b) determining a domain space about the name to be monitored, the domain space including at least one domain variation of the name to be monitored;
  - (c) searching a database of domain name registrations to identify one or more registrations of domain names that match the at least one variation of the name being monitored; and
  - (d) notifying the requestor of the identified one or more registrations,
- wherein subsequent to said receiving (a) of the request to monitor the name, said searching (c) and said notifying (d) are periodically automatically performed.

As for element (a), “receiving a request to monitor a name”, the Examiner references Fig. 2 of Gardos. While Fig. 2 provides a domain name selection screen, col. 5, lines 64-66 states that such screen “appears to prompt for the domain name to be modified or managed by the operator.” In general, Gardos describes a system and method for managing existing domains. Hence, the domain name entered using Fig. 2 is to manage of such domain. In contrast, the claim 1 is monitoring domain name registrations. Gardos offers merely management of existing domains, not monitoring for domain name registrations. Gardos thus fails to teach or suggest element (a) of claim 1.

As for element (b), “determining a domain space about the name to be monitored, the domain space including at least one domain variation of the name to be monitored”, the Examiner points to Figs. 5 and 6. Fig. 5 merely allows a user to assign aliases to a particular domain [victoriakarol.com], and Fig. 6 merely allows the user to specify mail servers for this particular domain. See Gardos, col. 7, line 60 to col. 8, line 46. Gardos thus fails to teach or suggest element (b) of claim 1.

As for element (c), “searching a database of domain name registrations to identify one or more registrations of domain names that match the at least one variation of the name being monitored”, the Examiner points to Figs. 5, 6, 7, 9 and 10. These figures of Gardos, however, offer no teaching or suggestion for “searching a database of domain name registrations to identify one or more registrations of domain names that match the at least one variation of the name being monitored” as recited in element (c) of claim 1.

As for element (d), “notifying the requestor of the identified one or more registrations”, the Examiner points to Figs. 5-10. While Figs. 5-10 of Gardos can display information concerned with management of a domain name, nothing in Gardos teaches or suggest anything about notifying a requestor of one or more registrations that are identified by the searching of element (c).

Accordingly, it is submitted that Gardos fails to teach or suggest any of elements (a) through (d) of claim 1.

The Office Action cites Meunier et al. for teaching that the operation of elements (a) through (d) are “periodically automatically performed.” First, Meunier et al. pertains to a document recommendation system. There is, therefore, no rational reason as to why one skilled in the art would seek to combine the domain management of Gardos with the document recommendation (e.g., document change information) of Meunier et al. Second, Meunier et al. fails to not only teach or suggest elements (a) through (d) of claim 1 but also fails to teach or suggest that such elements are “periodically automatically performed.”

Accordingly, it is submitted that claim 1 is patentably distinct from Gardos and Meunier et al.

Claim 11 pertains to a method for monitoring domain name registrations. The method recites:

- (a) receiving a request to monitor a name;
- (b) searching a database of domain name registrations to identify one or more registrations of domain names that match the name being monitored;

- (c) notifying the requestor of the identified one or more registrations; and
- (d) sending warning messages to registrants of the identified one or more registrations.

Not only does Gardos fail to teach or suggest elements (a) through (c) of claim 11 for reasons similar to those noted above with respect to claim 1, but Gardos also fails to teach or suggest element (d) which sends warning messages to registrants of those one or more registrations that have been identified by the searching. Fig. 4 mentions an authorization email being sent; however, an authorization email such as used in Gardos is not a warning message to registrants of those one or more registrations that have been identified by the searching as matching the name being monitored. Accordingly, it is submitted that claim 11 is patentably distinct from Gardos and Meunier et al.

Claims 13 and 20 also pertain to method for monitoring domain name registrations. Elements (a) through (c) of claims 13 and 20 are similar to elements (a) through (c) of claim 11. Hence, for at least the associated reasons noted above with respect to claim 11, it is submitted that claims 13 and 20 are patentably distinct from Gardos and Meunier et al.

Hollenbeck et al. also does not overcome the various deficiencies of Gardos and Meunier et al.

Based on the foregoing, it is submitted that claims 1, 11, 13 and 20 are patentably distinct from Gardos, Meunier et al. and/or Hollenbeck et al. In addition, it is submitted that claims 2-10, 12, 14-19, 21-27 and 31-37 are also patentably distinct for at least the same reasons as their corresponding independent claim. The additional limitations recited in the independent claims or the dependent claims are not further discussed as the above-discussed limitations are clearly sufficient to distinguish the claimed invention from Gardos, Meunier et al. and/or Hollenbeck et al.

Thus, it is respectfully requested that the Examiner withdraw the rejection of claims 1-27 and 31-37 under 35 USC § 103(a).

## **Conclusion**

It is believed that above-identified patent application into condition for allowance. Early favorable consideration of this Response is earnestly solicited and Applicant respectfully requests that a timely Notice of Allowance be issued in this case

If there are any issues remaining which the Examiner believes could be resolved through either a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number listed below.

Applicant hereby petitions for an extension of time which may be required to maintain the pendency of this case, and any required fee for such extension or any further fee required in connection with the filing of this Amendment is to be charged to Deposit Account No. 50-0388 (Order No. RLC1G000).

Respectfully submitted,

/C. Douglass Thomas/

C. Douglass Thomas  
Reg. No. 32,947

(408) 252-9991 x701